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OFFICE OF PETITIONS

In re Application of :
Joerg Rheims, Oliver Heise, Klaus :
Doelle, Ronald Sigl, Werner Witek : DECISION REFUSING
Application No. 10/672,817 : STATUS UNDER § 1.47(a)
Filing Date: September 26, 2003 :
Attorney Docket No. VOI0276.US :

This is in response to the "PETITION FOR FILING DECLARATION AND POWER OF ATTORNEY UNDER 37 C.F.R. §1.47(b)," filed April 19, 2004, which is being treated as a petition under 37 CFR 1.47(a).¹

The petition under 37 CFR 1.47(a) is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventors. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 CFR 1.136(a).

¹ A petition under 37 CFR 1.47(b) is only applicable when all of the inventors refuse to execute the application for patent.

The above-identified application was filed on September 26, 2003, without an executed oath or declaration. Accordingly, a Notice to File Missing Parts of Nonprovisional Application was mailed on December 19, 2003. This Notice set an extendable period for reply of two months. On April 19, 2004, applicants filed the instant petition, made timely by obtaining a two month extension of time.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor(s) cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 37 CFR 1.63; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor(s). The instant petition does not satisfy requirements (1) and (2).

As to requirement (1), there has been no showing that Oliver Heise was presented with the application papers (specification, claims, drawings, oath or declaration). Rather, the petition only establishes that Heise was forwarded a copy of the declaration and assignment forms. Regarding this, the Manual of Patent Examining Procedure states:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers.

It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 U.S.P.Q. 80 Comm'r Pat. 1956).

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient.²

² MPEP 409.03(d).

As to requirement (2), petitioner has failed to submit an oath or declaration in compliance with 37 CFR 1.63. The declaration is not acceptable because it contains a non-initialed, non-dated alteration to the post office address of inventor Werner Witek.³ Regarding this, the Manual of Patent Examining Procedure states that it is "improper for anyone, including counsel, to alter, rewrite, or partly fill in any part of the application, including the oath or declaration, after execution of the oath or declaration by the applicant." Furthermore, the Office "will not consider whether noninitialed and/or nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration."⁴

On renewed petition, applicants must submit a declaration in compliance with 37 CFR 1.63.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
 Commissioner for Patents
 P.O. Box 1450
 Alexandria VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-0272.



Cliff Congo
Petitions Attorney
Office of Petitions

³ "Any interlineation, erasure, cancellation or other alteration of the application papers...should be dated and initialed or signed by the applicant on the same sheet of paper." 37 CFR 1.52(c)(1).

⁴ MPEP 605.04(a).